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IN THE

Supreme Court of the United States

October Term, 1966
No. 312

MAX J. LUGASH and MAXON INDUSTRIES, INC.,
Petitioners,

vs.

SANTA ANITA MFG. CORP.,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITIONERS' PETITION FOR WRIT OF CERTIORARI.

Respondent hereby opposes the Petition for Writ of Certiorari filed herein by Petitioners on the primary ground that no special or important reasons exist for review by this Court.

JURISDICTION.

The grounds for jurisdiction, the constitutional provisions involved and the references to the opinions below are adequately set forth in the Petition and will be referred to herein.

NO JUSTICIABLE QUESTION PRESENTED.

The alleged questions presented on page 2 of the Petition are hypothetical, without substance and misleading. When the two questions concocted by Petitioners are stripped of their sophistry, it becomes evident that the actual question has been previously an-

swered by this Court. Petitioners are asking this Court to relax the standard of patentability and the questions should be stated:

> Did Congress by enacting 35 U.S.C. 103 and the Supreme Court in deciding *Graham v. Deere* 383 U.S. 1 (1966) intend to lower the standard of patentability applied by the Supreme Court in its prior decisions?

This Court has disposed of that question—

> "We have been urged to find in Section 103 a relaxed standard, supposedly a Congressional reaction to the 'increased standard' applied by this Court in its decisions over the last twenty or thirty years. The standard has remained invariable in this Court."
>
> 383 U.S. at 19.

This Court has made it clear that the standards of cases such as *Hotchkiss v. Greenwood,* 11 How. 248, *Lincoln Engineering Co. v. Stewart-Warner Corp.* 303 U.S. 545 and *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.* 340 U.S. 147, have not been overruled.

> "We believe that this legislative history as well as other sources, show that the revision was not intended to change the general level of patentable invention."
>
> 383 U.S. at 17.
>
> "* * *, it bears repeating that we find no change in the general strictness with which the overall test is to be applied."
>
> 383 U.S. at 19.

It is submitted that the Petition for Writ of Certiorari should be denied since it does not present questions within the purview of Rule 19 of this Court. This Court should not waste its time on moot questions.

FACTUAL STATEMENT OF THE CASE.

In the statements prefacing the companion cases considered by this Court in *Graham v. John Deere,* 383 U.S. 1 (1966), this Court stated:

> "Manifestly, the validity of each of these patents turns on the facts."
>
> 383 U.S. at 5.

In order to emphasize the futility and baseless character of the Petition, Respondent submits a brief factual presentation from the decision of the Court of Appeals for The Ninth Circuit in this tailgate loader case.

> "* * * Lugash '227 is a combination of two known elements, a parallel linkage system (taught by the previous Novotney Patent No. 2,194,403 issued in 1940) and an invertible platform (taught, e.g. by the previous Narvestad Patent No. 2,680,529 of 1954). * * *" (Petition, Page 33.)

The use of power for raising and lowering the parallel linkage system is shown in these patents as well as in many older patents. The platform is that portion of the device upon which a load can be placed and lifted onto the truck by the linkage. The provision of a hinge so as to permit the platform to be pivoted or

moved from a horizontal position to an upright or even an inverted position, is also extremely old.

"* * * Appellant states that the inversion of the platform is done manually. (Appellant's Opening Brief, p. 6.) Appellees admit the same. (Appellees' Brief, p. 6, lines 11-13) The court found as a fact that the inversion was manual. (Finding of Fact No. 6, C.T. 663-64)

"Invertible platforms were not unknown to previous loader components. Novotney showed a folding or inverted platform. The court found this inversion was 'mechanically possible' (Finding No. 16) but not 'inherent' (Finding No. 17) in Novotney. We think if 'mechanically possible' it is disclosed by prior art." (Petition, Page 36.)

"* * * An examination of the Novotney patent (1940) clearly shows that the only possible way to raise or lower the lifting arms, whether the platform is extended or inverted, is with the power means. The only conclusion we can reach is that the use of a power means to elevate the lifting arms, *whether the platform is inverted or extended,* **is neither an innovation nor a new function** unique to Lugash '227.

"We therefore conclude that the Lugash '227 patent has not been shown to perform a new or unexpected function in light of the prior art. *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp., supra,* dictates that the patent is therefore invalid." (Petition, Page 37.)

On these uncontroverted facts, the Court of Appeals was compelled to hold the patents invalid in view of

the provisions of §§ 101, 102 and 103 or any two of them, of Title 35 U.S.C. and this Court's specific admonition that there is "no change in the general strictness with which the test is to be applied." Certainly, the combination of admittedly old elements is not new (§101) and it was described in printed publications and patents mor than one year prior to the date of the application (§102). The Court of Appeals was cognizant of this Court's opinion since it specifically referred to *Graham v. John Deere Co.* and stated:

> "Where the subject matter of the patent would have been obvious to one skilled in the art at the time of the invention, no patent can be issued. 35 U.S.C. §103."

The Trial Court (whose Judgment was the subject of appeal to the Court of Appeals here) had specifically held that Petitioners' patent "2,989,196 is invalid under 35 U.S.C. 103" (Petition, Page, 28, Item 8). The Court of Appeals confirmed the Trial Court's finding of invalidity as to this patent.

It also referred to this Court's standards of invention which have remained invariable for a great many years, including *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545 and *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 137. The Court of Appeals did not specifically or extensively discuss §103 in its opinion but on the facts, it was forced to hold the patent invalid because it failed to comply with each of the provisions of §§ 101, 102 and 103.

PETITIONERS FAIL TO ADVANCE A REASON FOR GRANTING THE PETITION.

The primary purported reason for granting the Writ, as stated by the Petitioners, is

> "The decision of the lower court declares as law that a combination of known elements cannot, under any circumstances, be patentable unless the elements perform a new function." (Petition, Page 7.)

The falsity and sophistry of this statement is emphasized by the phrase "under any circumstances". To compound the falsity, Petitioners state on page 10

> "The logical consequence of the Ninth Circuit's position is that no patent for a combination of known mechanical elements can be valid."

It is submitted that these purported "reasons" are false and Petitioners intentionally misrepresent. Less than four months after their decision in the instant case, the Ninth Circuit held valid a claim on a combination of old elements in *Hensley Equipment Co. Inc. v. Esco Corp.*, 373 F. 2d 432. This clearly indicates that the Ninth Circuit acknowledges the accuracy of this Court's observation that "the validity of each of these patents turns on the facts". The Court of Appeals for the Ninth Circuit is not declaring as law that a combination of known elements cannot under any circumstances be patentable unless an element performs a new function.

In the *Hensley Equipment Case,* the Appellate Court compared the old combination with a prior patent and found that three features of a certain claim, while individually old in the art produce a "beneficial coaction" which was not obtained in the prior art patents. Certain stresses were transmitted from the tip of the wear point to the adaptor and leap-frogged a pin, whereby deformation of the pin was avoided.

This "beneficial coaction" could also be termed an operative mechanical distinction (a phrase employed by this Court in the *Graham* case).

The decision of the Ninth Circuit holding Petitioners' patent invalid, specifically states that the patent **does not involve an innovation.** Innovation is defined as "the introduction of something new"; "something that deviates from established doctrine or practice" (Webster's Third New International Dictionary). In the instant case they also concluded that there was **no new function.** In the *Hensley Equipment Case,* the Ninth Circuit found a beneficial coaction which indicates that they were aware of this Court's decision in *U.S. v. Adams* 383 U.S. 39 at 51 wherein this Court stated that the Adams battery **"wholly unexpectedly"** had shown "certain valuable advantages over other batteries" (and was an innovation since it deviated from established doctrine or practice).

It is submitted that as long as general rules laid down by this Court and stated in the Patent Act are applied to admitted and uncontroverted facts, a Writ of Certiorari should not be granted on a play of words.

CONCLUSION.

It is respectfully submitted that the Petition for Writ of Certiorari should be denied since it does not present questions within the purview of Rule 19 of this Court or requiring judicial review by this Court. The Judgment of the Court of Appeals for the Ninth Circuit (which this Court is asked to review by the Petitioners) is not in conflict with the decisions of this Court or any other Court. No new question of federal law has been decided by the Ninth Circuit. The hypothetical and strained questions presented by the Petitioners are simply an attempt to restate questions previously settled by this Court. Finally, this Court should not waste time on moot questions or on subject matter which is not of public interest; Petitioners' invalid patents relate to power driven elevator loaders for trucks and are indistinguishable from similar loaders used twenty-five to thirty years ago (compare Appx. C, pp. 1, 2 and 3 of App. Op. Br., Volume II, R. 734).

Respectfully submitted,

C. A. MIKETTA and
WILLIAM POMS of
MIKETTA, GLENNY, POMS & SMITH,
Attorneys for Respondent.